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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/663,415	09/16/2003	Tommy F. Grigsby	2003-IP-010777U1	2713

7590 03/24/2005

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EXAMINER

COLLINS, GIOVANNA M

ART UNIT	PAPER NUMBER
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3672

DATE MAILED: 03/24/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/663,415

Applicant(s)

GRIGSBY ET AL.

Examiner

Giovanna M. Collins

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 September 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-37 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-37 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 16 September 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 20030916.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Double Patenting

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 1,6,16,17,27,28 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1,6,12,66-68, 70 and 82-84 of copending Application No. 10/607,011 to Nguyen et al. Although the conflicting claims are not identical, they are not patentably distinct from each other because Nguyen claims a sand control screen with a compressible foam element which is held compressed by a degradable wrap and thus are obviously directed to the same invention.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1,6-11,15-22,26-33 and 37 are rejected under 35 U.S.C. 102(e) as being anticipated by Nguyen et al. 2004/0261994 (application 10/607,011).

The applied reference has a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C.

102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention “by another,” or by an appropriate showing under 37 CFR 1.131.

Referring to claim 1, Nguyen discloses (fig. 5-6) a method for temporarily maintaining a compressible foam element in a compressed state against an outer surface of a downhole sand control device, comprising the steps of: (a) installing a production assembly downhole within a casing string or well bore, the production assembly comprising a degradable wrap (120) securely fitted around the compressible foam element (118) so as to cause the compressible foam element to assume a compressed configuration against the downhole sand control device, and (b)

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degrading the degradable downhole wrap (page 12, claim 12) thereby causing the compressible foam element to expand into contact with the casing string or well bore.

Referring to claims 6,17, and 28, Nguyen discloses the degradable wrap is biodegradable and gradually degrades by thermal hydrolysis in the presence of the aqueous solution (page 12, claim 12).

Referring to claims 7,18,29, Nguyen discloses the wrap is in the form of a string or tape (paragraph 0014) which is helically wound around (see fig. 5) the compressible foam element.

Referring to claims 8,19,30, Nguyen discloses the wrap is forming into a tubular sheath (see fig. 5, at 120).

Referring to claims 9,20,31, Nguyen discloses the sheath is in the form of a woven cloth (paragraph 0062).

Referring to claims 10,21,32 Nguyen discloses the wrap comprises a degradable polymer consisting of homopolymers, random, block, raft and star and hyper-branched polyesters (paragraph 0063).

Referring to claims 11,22,33 Nguyen discloses the wrap comprises a degradable polymer consisting of polylactides (paragraph 0063).

Referring to claims 15,26,37, Nguyen discloses the wrap is permeable (paragraph 0063)

Referring to claims 16 and 27, Nguyen discloses a production assembly, comprising: a base pipe (fig. 1, at 30); a sand control device (40) incorporated within, or mounted to, the base pipe; a compressible foam element (118) mounted to the sand control device; and a degradable wrap (120) securely fitted around the compressible foam element so as to cause the compressible foam element to assume a compressed configuration.

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3. Claims 1,6,16,17,27-28 are directed to the same invention as that of claim 1,6,12,66-68, 70 and 82-84 of commonly assigned application 10/607011. The issue of priority under 35 U.S.C. 102(g) and possibly 35 U.S.C. 102(f) of this single invention must be resolved.

Since the U.S. Patent and Trademark Office normally will not institute an interference between applications or a patent and an application of common ownership (see MPEP § 2302), the assignee is required to state which entity is the prior inventor of the conflicting subject matter. A terminal disclaimer has no effect in this situation since the basis for refusing more than one patent is priority of invention under 35 U.S.C. 102(f) or (g) and not an extension of monopoly.

Failure to comply with this requirement will result in a holding of abandonment of this application.

4. Claims 1,6,15-17,26-28, and 37 are rejected under 35 U.S.C. 102(b) as being anticipated by Miller 3,099,318.

Miller discloses (figs. 1 and 3) a method for temporarily maintaining a compressible foam element in a compressed state against an outer surface of a downhole sand control device, comprising the steps of: (a) installing a production assembly downhole (16) within a casing string or well bore, the production assembly comprising a degradable wrap (42) securely fitted around the compressible foam element (col. 3, lines 1-9) so as to cause the compressible foam element to assume a compressed configuration against the downhole sand control device, and (b) degrading the degradable downhole wrap (col. 5, lines 15-25) thereby causing the compressible foam element to expand into contact with the casing string or well bore.

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Referring to claims 6,17, and 28, Miller discloses the degradable wrap (40) is biodegradable and gradually degraded by thermal hydrolysis in the presence of the aqueous solution (col. 5, lines 15-25).

Referring to claims 16 and 27, Miller discloses a production assembly, comprising: a base pipe (16); a sand control device (40) incorporated within, or mounted to, the base pipe; a compressible foam element (col. 3, lines 1-9) mounted to the sand control device; and a degradable wrap (42) securely fitted around the compressible foam element so as to cause the compressible foam element to assume a compressed configuration.

Referring to claims 15,26,37, Miller discloses the wrap is permeable (col. 5, line 6-8).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 2-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Miller '818 in view of Wehunt et al. 5,507,345.

Miller does not disclose the step of isolating a section of the production assembly. Wehunt teaches isolating a section of a production assembly to prevent undesirable fluids from entering a desirable fluid production interval (col. 5, lines 31-35). As it would be advantageous to prevent water from entering a oil production interval, it would be obvious to one of ordinary

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skill in the art at the time of the invention to modify the method disclosed by Miller to isolate a section of the production assembly as taught by Wehunt.

Referring to claim 3, Wehunt teaches (fig. 4) installing an isolation pipe (46) having a top end and a bottom end inside a production assembly and sealing (at 35 and 44) the isolation pipe to the production assembly.

Referring to claim 4, Wehunt teaches the isolation pipe inside the production assembly is performed after the step of installing production assembly downhole in the casing string or well bore and production has been flowing for a period of time (col. 11, lines 30-48).

Referring to claim 5, Wehunt teaches a coil tubing is employed to install the isolation pipe and to seal the top and bottom ends of the isolation pipe (col. 8, lines 52-54).

7. Claims 7-9,18-20 and 29-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Miller '818 in view of Voll et al. 6,607,032.

Referring to claims 7,18, 29, Miller discloses the wrap is in the form of a string or tape (col. 72-75) but does not disclose it is helically wound around the compressible form element. Voll teaches a layer that is helically wound around a filter (fig. 1, at 32). As it would be advantageous to helical wind the wrap to ensure the compressible form element stays in place as the assembly is being installed it would be obvious to one of ordinary skill in the art at the time of the invention to modify the wrap disclosed by Miller to be helically wound as taught by Voll.

Referring to claims 8,19,30, Voll teaches the forming a tubular sheath (fig. 1 at 32).

Referring to claims 9,20,31, Voll teaches the tubular sheath is form of a woven cloth.

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8. Claims 10-14,21-25 and 32-36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Miller '818 in view of Sinclair 5,216,050.

Referring to claims 10,21,32 Miller does not disclose the wrap comprises a degradable polymer consisting of homopolymers, random, block, raft and star and hyper-branched polyesters. Sinclair teaches these types of polymers are environmentally degradable (col. 1, lines 33-36). As it would be advantageous to have a wrap that will not harm the environment, it would be obvious to one of ordinary skill in the art at the time of the invention to modify the wrap to made of degradable polymer consisting of homopolymers, random, block, raft and star and hyper-branched polyesters as taught by Sinclair.

Referring to claims 11,22,33 Miller does not disclose the wrap comprises a degradable polymer consisting of polylactides. Sinclair teaches these types of polymers are environmentally degradable (col. 1, lines 33-36). As it would be advantageous to have a wrap that will not harm the environment, it would be obvious to one of ordinary skill in the art at the time of the invention to modify the wrap to made of degradable polymer consisting of homopolymers, random, block, raft and star and hyper-branched polyesters as taught by Sinclair.

Referring to claims 12,23,34, Sinclair teaches the polymer comprises an aliphatic polyester having the disclosed formula (col. 2, lines 55-64).

Referring to claims, 13,24,35, Miller does not disclose the wrap has a plasticizer. Sinclair teaches adding a plasticizer to a polymer composition improves processing characteristics during the blending and processing steps (col. 3, lines 30-35). As it would be advantageous to improve processing characteristics during the blending and processing steps, it

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would be obvious to one of ordinary skill in the art at the time of the invention to further modify the wrap disclosed by Miller to have a plasticizer as taught by Sinclair.

Referring to claims 14,25,36, Sinclair teaches the plasticizer comprises an oligomeric lactic acid having the disclosed formula (col. 3, lines 13-28).

Conclusion

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. U.S. Patents 2,981,332 and 2981,333 to Miller et al. both disclose a sand control apparatus with degradable wrap.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Giovanna M. Collins whose telephone number is 703-306-5707. The examiner can normally be reached on 6:30-3 M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David J. Bagnell can be reached on 703-308-2151. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished

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applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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